



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,848	02/05/2004	John M. Barrie	IPARA-08769	5758

7590 04/06/2006

David A. Casimir
MEDLEN & CARROLL, LLP
Suite 350
101 Howard Street
San Francisco, CA 94105

EXAMINER

VAUGHN, GREGORY J

ART UNIT PAPER NUMBER

2178

DATE MAILED: 04/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/772,848

Applicant(s)

BARRIE ET AL.

Examiner

Gregory J. Vaughn

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Action Background

1. This action is responsive to the application filing, application filed on 2/5/2004.
2. Claims 1-13 are pending in the case, claims 1 and 7 are independent claims.
3. Acknowledgement is made to the applicant's submission of a Preliminary Amendment and new drawings, filed on 10/7/2004.

Priority

4. Applicant's claim for domestic priority under 35 U.S.C. 119(e) of US provisional application 60/447,379, filed 2/13/2003 is acknowledged.

Drawings

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description:

- "4" on page 3, line 2
- "Fig 16, section 2" on page 11, line 7
- "1a, 1b, 2a, 2b, 3a, 3b, 3c, 4a, 4b, 4c, 4d, 4e, 5a, 5b, 5c, 5d, 5e, 14,a, 5f, 6e/f, 6b, 6c, 6n, 12b, 12a, 4f, 8a, 8b, 8c, 8d, 7d, 9a, 9b/c,

Art Unit: 2178

9f, 6j, 3d/11" on page 9, line 29, to page 12, line 5. Note: Figures 1-12 fail to contain reference symbols to identify the various elements of applicant's invention.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

6. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description:

- "a" in Figure 14.

A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

7. The disclosure is objected to because the disclosure section entitled "*Description of the Drawings*" (page 1) does not include a description for Figure 15a. Appropriate correction is required.
8. The disclosure is objected to because of the following informalities:
- The disclosure recites those reference signs listed in paragraph 5 above, which are not shown in the drawings.

Art Unit: 2178

- The disclosure fails to disclose those reference signs listed in paragraph 6 above, which are shown in the drawings.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

"The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention. "

10. Claims 4 and 13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 4 and 13 are directed toward *"assessing the originality of said received document"*, however the disclosure is silent as to how this determination is to be made. The disclosure recites *"detecting plagiarism of documents"* (page 3, line 20) as a benefit of the assessing process, however this statement fails to enable the artisan to make or use the invention, as required.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

"A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language."

12. Claims 1-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Shanahan et al. US Patent Publication 2005/0022114, filed 12/5/2001, published 1/27/2005 (hereinafter Shanahan).

13. **Regarding independent claims 1 and 7**, Shanahan discloses receiving a document over an electronic communication network. Shanahan recites: *"In one operational embodiment, multifunctional (i.e., fax, scan, print, store, email) device 512 scans in a document 614"* (paragraph 179). Shanahan discloses the multifunctional device 512 as part of an electronic communication network in Figure 5, reference sign 516 (shown as "Intranet"). Shanahan discloses converting the unformatted document into a formatted document. Shanahan recites: *"document content is detected and converted to a digital form"* (paragraph 179). Shanahan discloses permitting a user to add

Art Unit: 2178

contextual markups to the formatted document to generate a markup document. Shanahan recites: *"Annotate" is used herein to mean to create a reference between an entity in a document, or region of a document, and some set of links, text segment, images, or embedded data"* (paragraph 117) and *"Document "mark-up" is used herein to mean the annotation applied to a document"* (paragraph 120). Shanahan discloses displaying the mark-up document. Shanahan recites: *"a visualization and interaction system that allows various levels of display and interaction of metadata-enhanced documents"* (paragraph 146).

14. **Regarding dependent claims 2, 8, 9 and 11**, Shanahan discloses the document as an image file (claims 2 and 11) as a manuscript (claim 8) and an educational assignment (claim 9). Shanahan recites: *"A "document" is used herein to mean an electronic (e.g., digital) or physical (e.g., paper) recording of information. In its electronic form, a document may include image data, audio data, or video data. Image data may include text, graphics, or bitmaps"* (paragraph 119) and *"continuous-education document service request. For example, a textbook document"* (paragraph 145)

15. **Regarding dependent claims 3 and 12**, Shanahan discloses the contextual markups are added to an invisible image that maps to said image file. Shanahan recites: *"A meta-document 100, for example, may be given a personality 104 that is: ... (c) private: marked to keep the document's metadata invisible to other documents"* (paragraph 149).

Art Unit: 2178

16. **Regarding dependent claims 4 and 13**, Shanahan discloses assessing the originality of the document. Shanahan recites: *"the scheduler will similarly identify a method 420 from service database 210 that will use the stock quote service to check the Company Name entities"* (paragraph 157).
17. **Regarding dependent claim 5**, Shanahan discloses storing information related to the document in a database. Shanahan recites: *"FIG. 45 is a flow diagram for creating and updating an entity database dynamically from the document information space"* (paragraph 59).
18. **Regarding dependent claim 6**, Shanahan discloses the information consisting of an identifier of a submitter. Shanahan recites: *"this invention relates to the use of a digitally readable personality identifier in a meta-document management system"* (paragraph 3).
19. **Regarding dependent claim 10**, Shanahan discloses the Internet in Figure 2 at reference sign 221.

Art Unit: 2178

Conclusion

20. The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

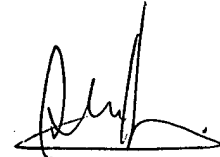
<u>Patent/Publication</u>	<u>Date</u>	<u>Inventor</u>
• US-6,732,090 B2	05-2004	Shanahan et al.
• US-6,778,979 B2	08-2004	Grefenstette et al.
• US-6,820,075 B2	11-2004	Shanahan et al.
• US-2002/0132216 A1	09-2002	Dohrmann, Bernhard
• US-2003/0033287 A1	02-2003	Shanahan et al.
• US-2003/0033288 A1	02-2003	Shanahan et al.
• US-2003/0061201 A1	03-2003	Grefenstette et al.
• US-2003/0069877 A1	04-2003	Grefenstette et al.
• US-2004/0205448 A1	10-2004	Grefenstette et al.
• US-2005/0022114 A1	01-2005	Shanahan et al.

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Vaughn whose telephone number is (571) 272-4131. The examiner can normally be reached Monday to Friday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached at (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is (571) 272-2100.

Art Unit: 2178

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



STEPHEN HONG
SUPERVISORY PATENT EXAMINER

Gregory J. Vaughn
March 31, 2006